

### REMARKS

In the Final Office Action of August 26, 2003, claims 1-7, 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Niermann et al. (U.S. Patent No. 5,354,267) in view of Russo (U.S. Patent No. 5,775,325).

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Niermann, Russo, and further in view of Reynolds (U.S. Patent No. 5,370,610).

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Niermann, Russo, Reynolds, and further in view of Loescher et al. (U.S. Patent No. 5,005,568).

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Niermann, Russo, and further in view of Reynolds.

Applicants respectfully request reconsideration of the allowability of the claims in the present application in view of the present remarks. Applicants submit that the present remarks raise no new issues and require no new search in the case.

Applicants respectively traverse the §103(a) rejection to claim 1. Applicants respectively submit that no motivation or suggestion exists for one skilled in the art to combined Russo with Niermann in the manner indicated in the Office Action. In fact, the references themselves explicitly teach to one skilled

in the art that they should not be combined with one another.

Russo is directed towards a two part closed tracheal suction system that is capable of maintaining positive end expiratory pressure (PEEP) when the two parts are connected to one another, and also when the two parts are disconnected from one another (see Russo at column 2, lines 49-53). In order to maintain PEEP when disconnected as shown in Fig. 4 of Russo, the tracheal suction system is provided with a valve 27 that has very thick side walls 29, 30 which are configured to only open when manual depression of buttons 24 and 25 occurs (see Russo at column 4, lines 35-36; and column 5, lines 50-55). By providing a valve 27 that is made of a thick material, the valve 27 is not able to be opened when a suction catheter is pressed against the valve 27, but only upon manual depression of the buttons 24, 25 by a user (see Russo at column 4, lines 37-43).

In stark contrast, the valve 74 shown in Niermann is configured to be opened when the suction catheter 18 is moved therethrough, this opening occurs without a user depressing buttons on the exterior of the structure in Niermann, but simply by moving the suction catheter 18 through the valve 74 (see Niermann at column 4, lines 40-50). As such, should Niermann be configured in order to be a two part device, PEEP would not be maintained due to the fact that the seal 74 of Niermann is not constructed of a thicker material.

In this regard, Russo specifically teaches against use of the Niermann value, as exemplified by the following language taken from Russo column 4, lines 32-43:

...Unlike the prior art duck bill valves mounted internally within the front connector (Niermann et. al. U.S. Pat. No. 5,345,267) the present invention valve 27 has thick not easily deformed side walls 29 and 30 of around 0.080 inches.

Unlike Niermann et. al. U.S. Pat. No. 5,345,267 or Bodi U.S. Pat No. 4,351,328 neither the valve 27 nor its slit 28 can be opened by inserting a relatively soft suction catheter because the present invention uses thick side walls 29 and 30 made from firm 75 Shore A Durometer material to keep both valve 27 and side walls 29 and 30 in a normally biased closed position.

Quoting again directly from Russo at column 2, lines 26-31:

...The Coles et. al. patent does show an internal duck bill valve similar to Niermann et. al. U.S. Pat. No. 5,354,267 but none of these prior art valves are manually deformable by the user's hand to enable ease of insertion or retraction of a catheter on its own.

Again quoting directly from Russo at column 1, line 66 to column 2, line 2:

...In effect this rotary valve acts fairly similar to the stopcock type arrangement of the Niermann et. al. U.S. Pat. No. 5,354,267 device which can also crimp the catheter when the valve is rotated.

Russo thus explicitly teaches to one skilled in the art that various features of Niermann, such as the stopcock valve 16,

valve 74, the single piece design, and the insertability of the catheter 18, are either disfavored or inferior to the closed tracheal suction system of Russo. As such, when one skilled in the art views both Russo and Niermann in their entirety, he or she would not have been motivated to combine the two references because Russo explicitly disclaims Niermann and teaches against such a combination.

In effect, if one skilled in the art were reading Niermann, he or she would not be motivated to combine any of the elements of Russo into Niermann because Russo explicitly teaches that Niermann is a disfavored inferior device. There is simply no motivation present, absent Applicants' specification, to make a respiratory suction apparatus as claimed in claim 1. Therefore, Applicants respectfully submit that the combination of Russo and Niermann is improper, and that claim 1 is allowable.

Therefore, Applicants respectfully submit that claim 1 is allowable, and that all claims which depend from claim 1 (claims 2-9) are also in condition for allowance. Their rejections being made moot due to the allowance of claim 1.

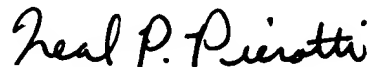
As stated, claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Niermann in view of Russo. For the reasons set forth above with respect to claim 1, Applicants respectfully traverse the §103(a) rejection of claim 10 over Niermann in view of Russo. As such, Applicants respectfully

submit that claim 10 is allowable, and that all claims which depend from claim 10 (claims 11 and 12) are also in condition for allowance. Their rejections being made moot due to the allowance of claim 10.

The Examiner is encouraged to call the undersigned at his convenience to resolve any remaining issues.

Respectfully submitted,

DORITY & MANNING, P.A.



---

Neal P. Pierotti  
Reg. No. 45,716  
P.O. Box 1449  
Greenville, SC 29602-1449  
(864) 271-1592  
FAX (864) 233-7342